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10/678,665	10/03/2003	Thomas Rumpf	RUMPF ET AL-4	9747

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EXAMINER

OMGBA, ESSAMA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

1. Applicant's arguments filed November 15, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that a work piece having a bearing eye which is directly coated with a gliding layer as recited in Applicant's claim 4 is nowhere disclosed or suggested in Schultz or Bank et al., the examiner submits that the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case the process could be applied to half-shell bearings as well as with work pieces with bearing eyes as attested by Applicant's disclosure in the "Description of the Prior Art" section of the specification.

In response to Applicant's argument that "a cutting (machining) for producing an exact circle form cylinder, as is done in Applicant's method as recited in claim 4 is neither purposeful for the methods taught by Schultz and Bank et al. nor provided in these references", the examiner submits that the features upon which Applicant relies (i.e., cutting (machining) to produce an exact cylinder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that neither Schultz by itself nor in combination with Bank et al. can render obvious Applicant's method as recited in claim 4, in that neither of these prior art even concern themselves with the problem to which Applicant's invention as recited in claim 4 is directed, the examiner respectfully disagrees. As clearly disclosed by Bank et al. in column 1, Bank et al.'s process finds application in friction bearings subjected to high dynamic loads (bearings for use in high load applications for journaling crank shafts). Furthermore just like in Applicant's invention, Bank et al. teaches a functional bearing layer produced from the same bath so as to produce a multilayer by varying the current density during plating, see column 3, lines 29-52 of Bank et al.

In view of the above remarks, the examiner maintains that a *prima facie* case of obviousness has been established in the instant application.